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OFFICE OF PETITIONS

In re Application of :
Matthews et al. :
Application Number: 10/825299 : DECISION ON PETITION
Filing Date: 04/16/2004 :
Attorney Docket Number: :
003797.00923 :

This is a decision on the petition, styled under 37 CFR 1.47(a) and filed on February 15, 2008, which is being treated as a petition under 37 CFR 1.183 seeking waiver of 37 CFR 1.131 in that it requires that a declaration filed thereunder by signed by all inventors.¹

The petition is **dismissed**.

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. **FAILURE TO TIMELY RESPOND WILL RESULT IN ABANDONMENT OF THE APPLICATION.** The reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.183."

This application was filed on April 16, 2004, and named Joseph H. Matthews, III, David Wm. Plummer, and David A. Barnes as joint inventors.

On February 15, 2008, the present petition, along with a declaration under 37 CFR 1.131 signed by joint inventors Matthews and Barnes.

Petitioners state that a copy of, *inter alia*, a declaration was sent by e-mail to the non-signing inventor on January 16, 2008, but that the non-signing inventor (Plummer) replied on January 17, 2008, confirming receipt of the Declaration, but stating that he would not sign the declaration. Petitioners further aver that

¹ Once an application has received a fully executed oath or declaration under 37 CFR 1.63 and been placed on the files for examination, the provisions of 37 CFR 1.47 no longer apply. See MPEP 603.

another request for Plummer to sign the declaration was sent by email on January 28, 2008, but that on January 29, 2008, Plummer again replied that he was refusing to sign the declaration.

Suspension of the rules under 37 CFR 1.183 may be granted in an "extraordinary situation, when justice requires." The facts presented on the record do not adequately establish an extraordinary situation. Petitioner has not sufficiently established any special circumstances of equities that would require suspension of the rules in the interests of justice.

There is no requirement for a showing under 37 CFR 1.47, as noted above. This application bears an original Declaration executed by all joint inventors, and thus, the provisions of 37 CFR 1.47 do not apply in this instance. Nevertheless, it is appropriate to apply the principles thereof to the situation at hand.

The showing of record is deficient in that the copies of email conversations referenced as exhibits in the petition cannot be located among the papers filed with the petition on February 15, 2008. Rather, the papers corresponding to the exhibits appear to be copies of correspondence sent with the original application papers rather than the documents sent with the affidavit under 37 CFR 1.131. Specifically, Exhibit A appears to be a copy of the original application for patent, while Exhibit B appears to be the cover letter transmitting the original application papers to the inventors, while the facsimile cover sheet and email included as Exhibit C, are dated August 26, 1997, nearly 10 years before the events recounted in the petition, and do not appear to pertain to the matters discussed in the petition.

Petitioner must include the relevant emails, and any other correspondence or documentation showing that the declaration under 37 CFR 1.131 was sent or given to Plummer at his last known address, but that Plummer refused to sign the declaration under 37 CFR 1.131.

Details of the efforts made to locate the non-signing inventor should be set forth in an affidavit or declaration of facts having first-hand knowledge of the details.

If repeated efforts to locate the inventor(s) and obtain the declaration under 37 CFR 1.131 are unsuccessful, petitioners will have shown that the inventor(s) cannot be located.

It is additionally noted that the fee for a petition under 37 CFR 1.183 is \$400.00, rather than \$200.00.² As such, counsel's deposit account, No. 50-1428, will be charged the additional \$200.00 as authorized in the present petition.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

By FAX: (571)273-8300
Attn: Office of Petitions

By hand: Customer Service Window
Mail Stop Petition
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Telephone inquiries related to this decision should be directed to the undersigned at 571.272.3231.



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² See 37 CFR 1.17(f).